



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BOARD OF PATENT APPEALS AND INTERFERENCES

Application No. 10/661,348	)	
	)	
First Names Inventor: Kim Tempest	)	Art Unit 3711
	)	
Filing Date: September 12, 2003	)	Examiner Kurt Fernstrom
	)	
Title: Gaming Apparatus and Method Having	)	Confirmation No. 6748
A Separate but Simultaneously Operating	)	
Bonus Indicator	)	
	)	
	)	

---

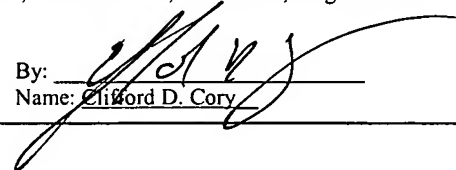
APPELLANT'S REPLY BRIEF

---

CERTIFICATE OF MAILING

I hereby certify that this document and any documents indicated as being enclosed therein are being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

on: April 10, 2009

By:   
Name: Clifford D. Cory

Board of Patent Appeals and Interferences  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Pursuant to 37 C.F.R. § 41.41 Appellant submits her Reply Brief in support of her appeal filed November 7, 2008 and in response to the Examiner's Answer mailed February 10, 2009 for the above-captioned application.

## **I. STATUS OF CLAIMS**

As set forth in Appellant's Brief, claims 1-9, 22-30, 32-41 and 49-51 stand rejected and are the subject of the instant appeal. Claims 10-21, 31 and 42-48 are cancelled.

## **II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

Whether the Examiner's rejection of claims 1-9, 22-30, 32-41 and 49-51 under 35 U.S.C. § 102(e) as being anticipated by Cannon is proper.

### III. ARGUMENT

Appellant respectfully submits that the Examiner is improperly construing the "bonus indicator" at the heart of her invention, and therefore improperly rejecting the application as anticipated by Cannon. The Examiner rejected the claimed invention as anticipated by Cannon on the grounds that the secondary slot machine games of Cannon can be and are considered "bonus indicators." *See* Examiner's Answer mailed February 10, 2009 ("Answer") at 5 ("The appellant is correct that the secondary games described in [the Cannon specification] are considered by the examiner to be a 'bonus indicator' and that any winnings from such games are considered by the examiner to be a 'bonus feature.'"). The Examiner does not credit Appellants' arguments that her bonus indicator is fundamentally different from a slot machine game as disclosed by Cannon and known in the art. Nor does the Examiner accept the limitations to Appellant's bonus indicator that she herself ascribes to that term and has made manifest in the patent specification. Once those limitations are understood and accepted, as they should be, Appellant's invention is novel and is not anticipated by the secondary games of Cannon.

**1. The Appellant's description of the bonus indicator in the specification can not be ignored.**

The Examiner initially argues that Appellant's "brief is deficient because it contains numerous features which are not recited in the claims." Answer at 3. This is also the Examiner's basis for not crediting Appellant's arguments and rejecting the application as anticipated by Cannon. *See* Answer at 5 ("[t]he appellant is essentially arguing that Cannon fails to disclose certain limitations which may be described in the [Appellant's] specification, but are not recited in the claims."). In so doing, however, the Examiner fails to honor Appellant's clear intent to describe and limit her own invention. Once that intent is credited and the "bonus indicator" of

the present invention is interpreted as Appellant intends it to be and as her patent specification indicates it should be, the basis for rejection is overcome.

The Examiner is required to "determine[] the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005) (*en banc*). "[T]he specification may reveal an intentional disclaimer, or disavowal, of claim scope by the inventor. In that instance ..., the inventor has dictated the correct claim scope, and the inventor's intention, as expressed in the specification, is regarded as dispositive." *Id.*; see also *Honeywell Int'l, Inc. v. ITT Indus. Inc.* 452 F.3d 1312, 1320 (Fed. Cir. 2006) (modifying district court's claim construction to exclude carbon fibers from the scope of the patent claims because patentee had disavowed that subject matter in the written description).

Appellant's written description limits her bonus indicator to a non credit awarding event; an event that simply indicates whether or not the player is entitled to a bonus round or feature. The Examiner acknowledges as much by noting that the limitations distinguishing Cannon are "described in the specification, but are not recited in the claims." Answer at 5. The Examiner erred in determining claim scope based solely on the basis of the term "bonus indicator," divorced from the written description of the invention.

**2. Appellant disavowed the play for credit aspect of the bonus indicator.**

As initially filed, Appellant's invention envisioned and disclosed a bonus indicator that operated, alternatively, either to indicate that the player would go on to a bonus round or to immediately award a secondary prize. See Initial Application mailed September 12, 2003 at 5,

lines 8-13 ("The primary game will directly yield an immediate reward if won; the bonus indicator, when stopped, will indicate whether the player will have an opportunity to potentially accumulate additional winnings during a bonus round of some sort or will receive some other secondary award or prize.") (emphasis added); *see also id.* at 8, line 22 to 6, line 1, ("Additionally, the player may achieve a positive outcome from the bonus indicator, which means that he will immediately attain a secondary prize of any of a wide variety of possible prizes or go on to a bonus round.") During prosecution, the intrinsic record reflects that Appellant consciously and unequivocally abandoned the secondary prize embodiment of the bonus indicator, focusing on the indicator as the mechanism to take the player to a bonus round and not as an independent award or credit generating event.

In her Response to Final Office Action and Request For Continuing Examination mailed October 3, 2006 ("RFOA") Appellant replaced the first paragraph on page 5, limiting the description of the bonus indicator by removing the secondary award aspect. "The primary game will yield an immediate result if won; the bonus indicator, when stopped, will indicate whether the player will have an opportunity to potentially accumulate additional winnings during the play of a bonus round or feature of some sort enabled by the bonus indicator." RFOA at 2. This change to the specification struck the language "or will receive some other secondary award or prize .... The secondary prize ... may consist of credits, money, or casino promotional items or messages." *Id.*

Likewise, Appellant replaced the paragraph beginning on page 8, line 10 and ending on page 8, line 23 changing the description of the bonus indicator as follows: "The primary game is won if a predetermined combination of symbols are achieved. Additionally, the player may

achieve a positive outcome from the bonus indicator, which means that he will be entitled to participate in a bonus round or feature." RFOA at 3. She also struck the language stating that a positive outcome from the bonus indicator means that the player will "immediately attain a secondary prize of any of a wide variety of possible prizes." *Id.*

The present application contains a specification that describes the bonus indicator as only that, an indicator that tells the player whether or not she will proceed to a bonus round or feature. Moreover, the prosecution history discussed above makes clear that the inventor has disclaimed the credit awarding aspect of the bonus indicator. As with the specification, "the prosecution history can often inform the meaning of the claim language by demonstrating how the inventor understood the invention and whether the inventor limited the invention in the course of prosecution, making the claim scope narrower than it would otherwise be." *Phillips*, 415 F. 3d at 1317. That is what Appellant has done here in deleting the alternative embodiment of a credit awarding bonus indicator.

Because the bonus indicator claimed by Appellant, as defined and understood in view of the patent specification and prosecution history, is different from the secondary game of Cannon, it is not anticipated by Cannon and the rejection based on Cannon is improper.

**3. The fact that Cannon may award a complimentary game is not dispositive.**

In her Appellant's Brief, Appellant acknowledged that Cannon discloses one embodiment where one of its credit awarding games is complementary and initiated by playing credits in another credit awarding game. Appellant's Brief at 15. The discussion in the Appellant's Brief of the bonus indicator of the invention being initiated by credit in the primary game was meant to distinguish the typical play of Cannon from the novelty of the bonus indicator. The fact that one

of Cannon's games can, in certain circumstances, be complimentary does not alter the fact that Cannon's games are ordinarily initiated by a wager on the game and are played for credit. Moreover, as pointed out in the Appellant's Brief, under the Examiner's construction whereby the secondary game of Cannon is the bonus indicator, the secondary game encompasses both the bonus indicator and bonus feature of the present invention, violating the all elements rule. Appellant's Brief at 15-17.

**4. The bonus feature has no special definition.**

The last paragraph of Examiner's Answer further evidences the misunderstanding and improper construction of the Appellant's claims. In that paragraph the Examiner states:

The 'bonus feature' in particular cannot have any special definition because the specification as originally filed did not even mention a 'bonus feature', much less provide a special definition. The amendment to the specification merely recites that a player may 'participate in a bonus round or feature'. On its face this does not constitute a special definition of 'bonus indicator' or 'bonus feature,' and it cannot be interpreted as such because to do so would result in the introduction of new matter into the disclosure.

Examiner's Answer at 6.

Appellant agrees. There is no special definition for the bonus feature of the invention and the limitations defined for the bonus indicator are found elsewhere, as discussed above. Unlike the bonus indicator and bonus feature of Cannon, which are interchangeable play for credit games, in the present invention they are unique and distinct. The bonus indicator is separate from both the primary game and the bonus feature, and operates differently from each.

The bonus feature of the invention was called a bonus game or bonus round in the initial application and is well known in the art. *See e.g.*, Application at page 1, lines 10-16; page 1, line 25; page 2, lines 1-5; page 5, line 12; claims 1, 11, 22, and 32. Appellant amended the




specification to call the bonus game or round a bonus feature because she felt that term better described the play for credit bonus event, which is a game but may also include additional graphics or other features. *See* RFOA *passim*. The use of a different, more precise term to describe an element in the original application does not introduce new matter into the specification. *See Transco Products Inc. v. Performance Contracting, Inc.*, 821 F. Supp. 537, 550 n.18, (N.D. Ill. 1993), *rev'd in part, vacated in part & remanded in part*, 38 F.3d 551 (Fed. Cir. 1994). The Examiner's objection on this basis should therefore be reversed.

#### IV. CONCLUSION

Because the separate, independent, simultaneously operating bonus indicator of the present invention, viewed in the context of the specification and prosecution history, is not played for credit it is distinguished from and not anticipated by the multiple games of Cannon. Appellant respectfully states that the Examiner's rejections have been overcome and that her patent application should be allowed.

Respectfully submitted,

  
\_\_\_\_\_  
Stephen C. McKenna, #44233  
1801 California Street, Suite 4200  
Denver, CO 80202  
Telephone: 303-298-5963